

REMARKS/ARGUMENTS

Initially, the Applicant would like to note that the Examiner's rejection of the Affidavit continues to be unclear. The July 5, 2007 Affidavit submitted under 37 C.F.R. § 1.132 was found to effectively remove WO 02/021936 as a prior art reference. On June 6, 2008, the Examiner reopened prosecution after Appeal and rejected claims 1-3, 5-21, 23-26, 33-34, 35-39, 41 and 48 as anticipated by U.S. Patent No. 6,800,907, the priority document to WO 02/021936. Initially, the Applicant submitted that, since the '907 U.S. Patent was equivalent in disclosure to the corresponding world publication, the U.S. patent was correspondingly removed as effective prior art based on the previously submitted affidavit. Still, based on a discussion with the Examiner, it appeared that an affidavit specifically identifying the '907 patent was desired. In an attempt to further the prosecution, the Applicant submitted another Affidavit on October 30, 2008 which mirrored the July 5, 2007 Affidavit but specifically identified the '907 patent. Now, it appears that the same language used before to remove the '936 WO reference as prior art is insufficient to remove its corresponding U.S. reference (U.S. Patent 6,800,907) as prior art. This USPTO position makes no sense to the Applicant and, despite attempting to obtain clarification through further phone calls to USPTO personnel, the Applicant is still at a loss to understand these seemingly clear, contradictory positions.

Again the Applicant submits that the previously filed Affidavits should be accepted by the Examiner and the rejection based on the '907 patent withdrawn. The outstanding Office Action indicates that the "affidavit cannot overcome the rejection over the US patent because the patent lists other people as inventors", "The current affidavit does not explain why the other inventors listed on the patent are not inventors. If they are not inventors, why would they be listed as inventors on the patent?" and "The affidavit contradicts the U.S. patent without any explanation." Hopefully, the arguments presented below will fully address the Examiner's concerns.

In order to remove a reference as a prior art document, the Patent Office requires a statement that the subject matter relied on for the rejection was the Applicant's own invention. As set forth in M.P.E.P. § 716.10:

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) **or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the other patentee or other applicant of the published application should not be required** but, if submitted, may be accepted by the examiner. (Emphasis added)

See also M.P.E.P. § 2136.05 stating that:

When a prior U.S. patent, ** U.S. patent application publication>,< or international application publication* is not a statutory bar, a 35 U.S.C. § 102(e) rejection can be overcome by antedating the filing date (see MPEP § 2136.03 regarding critical reference date of 35 U.S.C. § 102(e) prior art) of the reference by submitting an affidavit or declaration under 37 CFR § 1.131 **or by submitting an affidavit or declaration under 37 CFR § 1.132 establishing that the relevant disclosure is applicant's own work.** *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969). The filing date can also be antedated by applicant's earlier foreign priority application or provisional application if 35 U.S.C. § 119 is met and the foreign application or provisional application "supports" (conforms to 35 U.S.C. § 112, first paragraph, requirements) all the claims of the U.S. application. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989) (emphasis added).

These provisions of the MPEP are specifically established for the exact situation of the present case. That is, when a prior publication or patent "filed jointly by S and another"(S representing the current application inventorship) is not a statutory bar and portions of the prior disclosure is being used to reject subsequent patent claims by "S", an affidavit by the Applicant(s) can be used to establish that the applicant (S) conceived or invented the subject matter disclosed in the patent or published application, thereby

establishing that the relevant disclosure is applicant's (S's) own work. The MPEP clearly equates a prior publication or patent, so the holding of the affidavit overcoming the WO publication being different from overcoming the corresponding US patent is seen to be in error. As for the questions as to why additional inventors are listed, well the inventorship is based on the claimed subject matter, not all the disclosed subject matter. Therefore, the inventors listed on the '907 patent are inventors of the **claimed** subject matter. The Examiner is not rejecting claims of the present application based on the claimed subject matter of the '907 patent, but is instead rejecting claims of the present application based on parts of the specification which recite utilizing ozone as an oxidant agent. See, for example, page 5 of the November 24, 2008 rejection in which the Examiner states that:

The discussion by Gonzalez et al starting on line 53 through column 10 line 5 is in relation to the bran treated with hydrogen peroxide; it is not related to product treated with ozone. Gonzalez et al do disclose embodiment in which the bran is treated with ozone; thus, the properties as claimed are inherent in the Gonzalez et al. product.

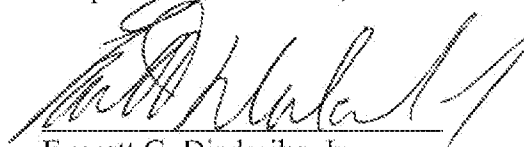
If the inventorship was the same, the present situation would not even arise and the Applicant would not be in the position of attempting to correct the Examiner on these points. Finally, the affidavit does not contradict the U.S. patent but rather explains that the different inventorship in the '907 patent is due to the claimed subject matter, but the disclosure relied upon by the Examiner in utilizing the '907 patent in the art rejection is attributable to the present Applicant. Therefore, it is unclear why the difference in inventorship between the '907 patent and the present Application is cause for rejecting the previous affidavit. The fact that the inventors of the present application invented some of the subject matter of the '907 patent is simply not cause for rejecting the previously filed affidavit.

With respect to the remaining rejection of claims 1-3, 5-9 and 16-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,844,924 to Stanley in view of U.S. Patent No. 4,372,812 to Phillips et al., the Applicant refers to the arguments made

in the Appeal Brief filed February 28, 2008. In summary, the combination applied by the Examiner does not employ the same mild ozone oxidation treatment, makes no mention of 0.1 to 1 parts ozone per 100 parts bran, makes no mention of reducing ferulic acid (let alone to less than 30 ppm) and has no disclosure on increasing the concentration of vanillin. Unless the Examiner can find some disclosure in the applied prior art to these specifically claimed inventive features, the rejections should be withdrawn.

Based on the above remarks, the Applicant respectfully submits that the present invention is patentably defined over the prior art of record such that allowance of all claims and passage of the application to issue are respectfully requested. If the Examiner should have any additional questions or concerns regarding this matter, she is cordially invited to contact the undersigned at the number provided below in order to further prosecution.

Respectfully submitted,



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